



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/707,309

12/04/2003

Fred Bishop

03292.101680.1

1308

66569 7590 10/27/2008

FITZPATRICK CELLA (AMEX)  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

10/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,309	<b>Applicant(s)</b> BISHOP ET AL.	
	<b>Examiner</b> AMEE A. SHAH	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-18 are pending in this action; claim 18 is withdrawn.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 16, 2008, has been entered.

#### ***Response to Amendment***

Applicant's Amendment and Remarks, filed July 16, 2008, have been entered. Claims 1, 4, 5 and 12-17 have been amended.

#### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35

U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/299,891, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The '891 application fails to provide adequate support for the limitations of claims 1-17 regarding authorizing a transaction including the steps of receiving an authorization request, issuing a challenge, receiving a response based on the challenge, sending an authentication request, authenticating the transaction using smart card information and receiving an authentication. Therefore, the priority date of claims 1-17 is the filing date of the current application, December 4, 2003.

***Examiner Note***

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Angles et al., US 6,385,591 B1, previously cited (hereafter referred to as “Angles”) in view of Greenberg, US 2003/0144913 A1, previously cited (hereafter referred to as “Greenberg”), further in view of Hartman et al., US 5,960,411, previously cited (hereafter referred to as “Hartman”), and further in view of Nambiar et al., US 2002/0128977 A1 (hereafter referred to as “Nambiar”)**

Referring to claim 1. Angles teaches a method performed by an interface device for facilitating interaction between a consumer and a merchant (*see, e.g.*, Figure 3). Angles teaches

Art Unit: 3625

an advertisement provider, which could be a computer, server or program (col. 13, lines 34-59), as the interface device as defined by the applicant (specification, ¶0017), receiving offer information from a content provider, i.e. merchant, via an electronic page or interactive television page with an embedded advertisement request, i.e. a broadcast that reaches a plurality of potential consumers, wherein said offer information relates to a product (*e.g.* Fig. 3, col. 7, line 65 through col. 8, line 43 and col. 9, lines 37-44). Angles further teaches the advertisement provider retrieving consumer preference information from a demographic database associated with the consumer (*e.g.* Fig. 3, col. 8, lines 19-24 and line 61 through col. 9, line 1, and col. 19, lines 53-63), amending the electronic page with an advertisement customized according to the consumer preference information, i.e. customizing the offer information received from the merchant via the broadcast according to the consumer preference information to create an amended offer for the consumer (*e.g.* Fig. 3, col. 8, lines 24-30, col. 9, lines 1-4 and col. 20, line 60 through col. 21, line 18), and transmitting the amended offer to a display for viewing by the consumer (*e.g.* Fig. 3, col. 8, lines 28-30 and col. 9, lines 5-10).

Angles does not teach receiving consumer identification information from a smart card associated with the consumer, the amended offer specifying a method of acceptance, receiving an acceptance of the amended offer associated with the amended offer and including smart card information, authorizing a transaction including receiving an authorization request, issuing a challenge to the consumer, receiving a response to the challenge, sending an authentication request, authorizing the transaction using smart card information and receiving an authentication, retrieving consumer payment information, amending the acceptance with the consumer payment information, and transmitting the amended acceptance to the merchant.

Greenberg teaches a method and apparatus for conducting electronic commerce where an email offer is sent to prospective customers, such offer specifying a method of acceptance (Fig. 2 and ¶¶0016 and 0018 – note the method of acceptance is the “Purchase ‘button’”), an acceptance is received from the consumer, wherein the acceptance is associated with the offer and the acceptance includes a security feature (Figs. 2 and 3, and ¶0018), the acceptance is amended with consumer payment information and identification information to create an amended acceptance (¶0021 – note the consumer payment information and identification are in the email in advance and the amended acceptance is performed by activating the “Purchase Using Default Options” button); and the amended acceptance is transmitted to the merchant (Fig. 3 and ¶¶0019 and 0021 – note the transmittal is performed by notifying the merchant server).

Greenberg does not teach receiving consumer identification information from a smart card, authorizing a transaction including receiving an authorization request, issuing a challenge to the consumer, receiving a response to the challenge, sending an authentication request, authorizing the transaction using smart card information and receiving an authentication, and retrieving consumer payment information from a database.

Hartman teaches a method and apparatus for placing an order to purchase by "one-click shopping" (see, e.g., Abstract). Hartman teaches storing by a server, i.e. an interface device, consumer payment information and identification information in a database (Figs. 2 and 3, col. 5, line 59 through col. 6, line 4 and col. 6, lines 48-50), retrieving by the interface device consumer payment information and consumer identification information from a database associated with the consumer (Fig. 3 and col. 6, lines 52-67) and amending by the interface device the acceptance with the consumer payment information and the consumer identification information

Art Unit: 3625

to create an amended acceptance upon receipt of the acceptance from the consumer by the interface device (Fig. 5 and col. 7, lines 25-30 – note the acceptance from the consumer is the single action needed to place the order).

Hartman does not teach receiving consumer identification information from a smart card, authorizing a transaction including receiving an authorization request, issuing a challenge to the consumer, receiving a response to the challenge, sending an authentication request, authorizing the transaction using smart card information and receiving an authentication.

Nambiar teaches a microchip-enabled online transaction system and method that uses a smart card, a smart card reader and a user specific identification signature to better authenticate a user. Nambiar teaches receiving consumer identification information from a smart card (Fig. 3 and ¶¶0028, 0045 and 0046 – note the host system receives the digital wallet from the smart card which contains consumer information), receiving an acceptance of an offer including smart card information (¶0045), and authorizing a transaction, wherein the authorizing includes the steps of: receiving, by a wallet server, an authorization request from the consumer (Figs. 3 and 5 and ¶0044 - note that the authorization request is the clicking on the smart card payment button); issuing, by the wallet server, a challenge to the consumer, wherein the challenge prompts the consumer to input the smart card information including a digital certificate uniquely identifying the smart card (¶0044); receiving, by the wallet server, a response from the consumer based upon the challenge, wherein the response includes the smart card information (¶¶0045 and 0046); sending, by the wallet server, an authentication request for the transaction including the smart card information to a security server (¶¶0045 and 0046); authenticating, by the security server, the transaction using the smart card information (¶¶0045 and 0048); and receiving, by the



interface device, an authentication for the transaction from the security server (Figs. 3, 5, 7 and 8 and ¶¶0020, 0028, 0045 and 0048).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of specifying a method of acceptance, receiving an acceptance associated with the offer and with a security feature, amending the acceptance with payment and identification information and transmitting the amended acceptance to the merchant, as taught by Greenberg, with the known elements of an interface device retrieving consumer payment and identification information and amending the acceptance with this information, as taught by Hartman, and the known elements of receiving consumer information from a smart card, receiving an acceptance with smart card information, and authorizing a transaction with a smart card, as taught by Nambiar, with an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg, Hartman, Nambiar and Angles would yield the predictable results of allowing for an electronic purchase to be more simply and securely conducted after an offer to sell is made, thereby leading to more business transactions completed and more profit.

Referring to claim 2. Angles/Greenberg/Hartman/Nambiar further teaches the method of claim 1 wherein the step of transmitting the amended offer to a display includes transmitting via at least one of television programming and an Internet broadcast (Angles, col. 9, lines 37-44).

Referring to claim 3. Angles/Greenberg/Hartman/Nambiar further teaches the method of claim 1 wherein the consumer preference information includes at least one of restriction information, demographic information, identification information, and shipping information (Angles, *e.g.*, col. 17, lines 15-22).

Referring to claim 4. Angles/Greenberg/Hartman/Nambiar further teaches the method of claim 1 wherein the step of receiving an acceptance from the consumer includes receiving an acceptance via at least one of a remote control, an electronic pen, a telephone, an automatic dialing device, a microphone, a pager, a radio-frequency device, a personal digital assistant, the smart card, a digital video recorder (DVR), a personal video recorder (PVR), and simulated button (Angles, col. 10, lines 43-52, Greenberg, ¶0016, and Nambiar, ¶0020 – note the computer can be a number of mechanisms, including a personal digital assistance, interactive television and wireless device, and that the acceptance can be any mechanism, including a mouse click, to indicate acceptance) in order to complete and effect a purchase.

Referring to claim 5. Angles/Greenberg/Hartman/Nambiar teaches the method of claim 1 wherein the smart card information includes a security feature including at least one of authentication, embedded certificate, consumer ID and password, identifier, data-encryption information, digital signature, secure file structures, and trusted third party downloads (Nambiar, ¶0027 – note the smart card included such security features as an embedded certificate and a digital signature, *i.e.* PIN,).

Referring to claim 6. Angles/Greenberg/Hartman/Nambiar also teaches the method of claim 1 wherein the consumer preference information, consumer payment information and consumer identification information are provided to at least one database in a registration process performed by the consumer (Angles, col. 14, lines 22-63 and col. 17, lines 1-51 and Hartman, col. 6, lines 48-60).

Referring to claim 7. Angles/Greenberg/Hartman/Nambiar also teaches the method of claim 1 further comprising the steps of authenticating the consumer (Angles, col. 19, lines 53-63 – note the authentication is extracting the consumer code and determining whether the user has registered), and managing consumer identities (Angles, *e.g.*, col. 16, lines 10-19 – note the management of consumer identities is the storing of information based on the consumer code).

Referring to claim 8. Angles/Greenberg/Hartman/Nambiar also teaches the method of claim 1 further comprising the step of analyzing attributes of the consumer to substantially predict an optimal offer content and context (Angles, *e.g.*, col. 16, lines 10-19 – note the analysis is based on consumer profile).

Referring to claim 9. Angles/Greenberg/Hartman/Nambiar further teaches the method of claim 1 wherein the step of amending includes amending the acceptance with at least one of consumer loyalty point information, authorization from an issuer, authorization from said system, security or wallet server authorization, consumer authentication and single use account

Art Unit: 3625

number information (Greenberg, ¶0021 – note the acceptance includes authorization from user, security server authorization and single use account number information from credit card).

Referring to claim 10. Angles/Greenberg/Hartman/Nambiar also teaches the method of claim 1 further comprising the step of developing at least one of a consumer transaction database and an offer evaluation database (Angles, col. 16, lines 10-20).

Referring to claim 11. Angles/Greenberg/Hartman/Nambiar further teaches the method of claim 1 wherein the step of transmitting the amended acceptance to the merchant includes at least one of authenticating the consumer and authorizing a transaction between the consumer and the merchant (Greenberg, Fig. 3 and ¶¶0019 and 0021, and Nambiar, ¶¶0044-0048).

Referring to claims 12, 13, and 15-17. All of the limitations in apparatus claims 12, 13, 16 and 17 are closely parallel to the limitations of method claims 1-11, analyzed above and are rejected on the same bases.

Referring to claim 14. Angles in view of Greenberg and Hartman also teaches the system of claim 12 wherein the application program causes the processor to perform a step of storing the offer information in an offer database (Angles, col. 12, lines 1-11 – note the offer database is the advertising storage medium).

***Response to Arguments***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Chen et al., US 7,096,204 B1, discloses a system and method for electronic commerce whereby smart cards are used to authorize and authenticate transactions (see, e.g., Abstract and columns 10-16).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amee A Shah/  
Examiner, Art Unit 3625

AAS

October 23, 2008